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**UNITED STATES PATENT AND TRADEMARK
OFFICE**

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Butler

Mail date: February 10, 2005

Cancellation No. 92043073

J.E.M. International, Inc.

v.

Happy Rompers Creations Corp.

**Before Chapman, Bucher and Drost, Administrative Trademark
Judges.**

By the Board:

Petitioner seeks to cancel respondent's registration for the mark IT'S A GIRL THING for a wide variety of clothing items. Respondent's subject registration is No. 2751107, issued on August 12, 2003, claiming use and use in commerce since June 20, 2002. The goods are identified as follows:

aprons, ascots, babies rompers, baby sleepers, babushkas, baby buntings, balloon pants, bandannas, bath robes, bathing suits, bathing trunks, beach cover-ups, belts, berets, Bermuda shorts, bikinis, blazers, blouses, body suits, boleros, boots, booties, boxers, bras, breeches, briefs, burp cloths, caftans, camisoles, caps, capes, chemises, cloth belts, cloth bibs, corselets, costumes, coveralls, cravats, crop tops, culottes, denim jackets, denim jeans, diaper covers, dresses, dressing gowns, earmuffs, evening gowns, fishing vests, frocks, gabardines, galoshes, garter belts, girdles, gloves, golf shirts, gym shorts, Halloween costumes, halter tops, hats, head wear, hooded tops, hoods, hosiery, jackets, jerseys, jogging suits, jumpers, kerchiefs, kimonos, kilts, knit pullovers, knit shirts, lab coats, leggings, leotards, loungewear, maillots, men's slacks, money belts, mufflers, neck bands, negligees, nightgowns, night shirts, nylons, pajama tops, pajama bottoms, pantaloons, pants, panties, pantsuits, parkas,

pedal pushers, pinafores, play suits, pocket squares, polo shirts, ponchos, quilted vests, rain coats, rompers, safety shoes, sandals, sashes, scarves, shawls, shirts, shoes, shoe laces, shorts, skirts, ski pants, sleep shirts, slippers, slips, smocks, sneakers, snow pants, snow suits, socks, sport bras, sport coats, sports uniforms, stockings, suit coats, sweaters, sweat pants, sunvisors, suspenders, sweatshirts, t-shirts, tops, tank tops, tap pants, thermal socks, thermal underwear, thongs, ties, tights, toe boxes, turtle neck sweaters, undershirts, uniforms, unitards, v-neck sweaters, veils, vests, visors, waistcoats, windshirts, wind resistant jackets, winter coats, workout tops and tights, wrist bands.

As grounds for cancellation, petitioner alleges that respondent's registered mark so resembles petitioner's previously used mark GIRL THING for clothing as to be likely to cause confusion, mistake or to deceive. Petitioner further alleges that respondent is not using, and has never used, the mark IT'S A GIRL THING on all of the goods identified in the application, Notice of Allowance, Statement of Use and subsequent registration; that respondent's Statement of Use claiming use of the mark on each of the goods identified in the application and Notice of Allowance was false; and that respondent procured its registration by falsely alleging in its Statement of Use that it is using the mark on all identified goods, and that the date of first use and first use in commerce for all the identified goods is June 20, 2002.

In its answer, respondent denies the salient allegations of the petition to cancel.

On May 26, 2004, respondent filed a motion to amend its registration to delete numerous items from the identification of

goods. Respondent identifies the goods to be deleted as follows

(copied from respondent's proposed amendment):

aprons, ascots, babies rompers, baby sleepers, babushkas, baby buntings, balloon pants, bandannas, bath robes, bathing trunks, Bermuda shorts, bikinis, blazers, body suits, boots, booties, boxers, bras, breeches, briefs, burp cloths, caftans, caps, capes, cloth belts, cloth bibs, corselets, costumes, cravats, culottes, diaper covers, dressing gowns, evening gowns, fishing vests, frocks, gabardines, galoshes, garter belts, girdles, golf shirts, gym shorts, halloween costumes, hooded tops, hoods, hosiery, jackets, jerseys, jogging suits, jumpers, kerchiefs, kimonos, kilts, knit pullovers, knit shirts, lab coats, leotards, loungewear, maillots, men's slacks, money belts, neck bands, negligees, nightgowns, night shirts, nylons, pantaloons, panties, pantsuits, pedal pushers, pinafores, pocket squares, safety shoes, sashes, scarves, shawls, shoes, shoe laces, sleep shirts, slippers, slips, smocks, sneakers, snow pants, snow suits, socks, sport bras, sport coats, sports uniforms, stockings, suit coats, sweaters, sweat pants, suspenders, thongs, tics, tights, toe boxes, undershirts, uniforms, unitards, veils, waistcoats, wind resistant jackets, winter coats, workout tops and tights, wristbands.

Petitioner filed a response in opposition to the proposed amendment. On July 1, 2004, and in accordance with Board practice, the Board deferred consideration of respondent's proposed amendment to its registration until final decision, or until the case is decided on summary judgment. See TBMP §514.03 (2nd ed. rev. 2004).

This case now comes up on petitioner's fully briefed motion, filed August 4, 2004, for summary judgment in its favor on its claim that respondent fraudulently procured its registration by falsely representing in its Statement of Use, which was accepted by the USPTO as a basis for issuing the resulting registration, that it was using the mark on all the goods identified in the application and Notice of Allowance. In view of petitioner's pending summary judgment motion, respondent's motion to amend its registration to delete goods is now ripe for determination.

As background, respondent (as applicant then) filed, on October 16, 2001, application Serial No. 76326255 for the mark IT'S A GIRL THING for a wide variety of clothing items (approximately 150), claiming a *bona fide* intention to use the mark in commerce. See Trademark Act §1(b). A Notice of Allowance was issued on October 15, 2002 for all of applicant's listed goods; and a first extension was filed and granted on April 3, 2003, contemporaneously with the filing of applicant's Statement of Use. Respondent (as applicant) used the standard electronic form for a Statement of Use; indicated "Yes" for "All goods and/or services in the Notice of Allowance" in identifying the goods upon which it is using the mark; and further indicated the first use and first use in commerce date as June 20, 2002. Registration No. 2751107 then issued on August 12, 2003 for all the goods indicated in the first paragraph of this decision, *supra*, which were all the goods identified in application and in the subsequently issued Notice of Allowance.

In support of its motion for summary judgment, petitioner argues that respondent fraudulently procured its registration by falsely stating in its Statement of Use that it was using the mark on all the over 150 items of clothing identified in the Notice of Allowance when respondent was not using, and has never used, its mark in connection with over 100 of the identified clothing items. Petitioner argues that respondent knew at the time it filed its Statement of Use that respondent was not using,

and had not used, the mark on over 100 of the over 150 clothing items; and that, upon receipt of its registration, respondent further failed to take corrective steps. Rather, petitioner argues, respondent took no steps to correct the registration until after the institution of this proceeding. Petitioner contends that, when an applicant fraudulently states use of a mark on various goods and does not use the mark on all the goods for which it sought a registration, cancellation of the entire registration is appropriate.

In addition to the pleadings, petitioner's motion is supported by the following:

- 1) the declaration of its attorney stating that petitioner, on May 28, 2003, filed an application to register its mark GIRL THING for "footwear, pajamas, robes, and nightgowns; sportswear, namely, tops, shorts and pants; underwear, hosiery and socks" (Serial No. 76520470); and that such application has been refused registration in view of respondent's existing registration. Petitioner's attorney further introduces a copy of the November 17, 2003 Office action refusing registration of petitioner's pending application.
- 2) A copy of respondent's Statement of Use, filed April 3, 2003.
- 3) A copy of respondent's responses to petitioner's first set of interrogatories.
- 4) A copy of respondent's responses to petitioner's requests for admissions.
- 5) A copy of respondent's responses to petitioner's first requests for production of documents and things.

In response, respondent argues that it never intended to make misrepresentations to the USPTO; that its failure to amend its application to divide or separate the goods upon which it is actually using its mark from those which it never offered was the

result of carelessness, not fraud; and that, upon realizing its mistake, respondent took corrective steps, seeking to amend its registration to delete those goods which it is not offering, nor has offered, under its mark. Respondent explains that its submission of the Statement of Use without a request to divide was an administrative error and oversight resulting from a lack of knowledge as to Trademark Office procedures; and that respondent did not advise its counsel to file a request to divide. Respondent argues that, because it lacked an intent to defraud the USPTO, petitioner has not carried its burden of establishing that no genuine issue of material fact exists, entitling petitioner to judgment in its favor as a matter of law.

Respondent's response is accompanied by the declaration of its president stating, among other things, that respondent never intended to make fraudulent representations to the USPTO concerning the products upon which it is using the mark; and that respondent took steps to correct its mistake.

In reply, petitioner argues that respondent's claims of mistake and unfamiliarity with Office procedure are rebutted by respondent's proffering in its Statement of Use that it is "... using or is using through a related company the mark in commerce on or in connection with all the goods/services listed in the Application/Notice of Allowance." Petitioner contends that no special knowledge is needed to understand the plain meaning of the term "all." Relying on the determination made in *Medinol*

Ltd. v. Neuro Vasx Inc., 67 USPQ2d 1205 (TTAB 2003), petitioner argues that respondent's mistake still resulted in the submission of a false statement of use; and that respondent's actual knowledge, or even implied knowledge and disregard therefor, that it was not using the mark on the identified goods, is sufficient to establish intent to commit fraud.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

We agree with petitioner that the holding in *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003) is applicable here.

A trademark applicant commits fraud in procuring a registration when it makes material representations of fact in its declaration which it knows or should know to be false or misleading. *Id.* at 1209, citing *Torres v. Cantine Torresella*

S.r.l., 808 F.2d 46, 1 USPQ2d 1483, 1484-85 (Fed. Cir. 1986). As in *Medinol*, respondent herein denies that its intent in submitting its statement of use was fraudulent. Ordinarily, cases involving questions of intent are unsuited to resolution by summary judgment. See, e.g., *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991). However, taking into consideration the circumstances of a case, the appropriate inquiry is not into the registrant's subjective intent, but rather into the objective manifestations of that intent. *Medinol v. Neuro Vasx*, 67 USPQ2d at 1209.

Here, respondent's application published for, and a Notice of Allowance issued for, over 150 clothing items. Notwithstanding that the mark was not in use on over 100 of these clothing items (2/3 the identified goods), respondent indicated when it filed its Statement of Use that the mark was in use on:

<GOODS AND SERVICES INFORMATION>
<ALL GOODS AND/OR SERVICES IN NOTICE OF ALLOWANCE> Yes
~ The applicant is using or is using through a related company the mark in commerce on or in connection with all the goods/services listed in the Application/Notice of Allowance. ~

(Copied from respondent's Statement of Use document.)

Among the items that respondent was not using the mark on when it filed its Statement of Use were the first nine items listed in the Notice of Allowance and resulting registration. In their position at the beginning of the list, such items would be the first to catch a reader's eye and bring into question the

breadth of actual use being made by respondent at the time of filing.

While respondent now acknowledges its error and, for purposes of this summary judgment motion, we accept its statement that it did not intend to make a misrepresentation and that its mistake was inadvertent, respondent filled in the form checking the box for use on "all" goods; respondent further made a statement that "all" the goods were being used in commerce by it or a related company; and respondent signed its statement of use under penalty of "fine or imprisonment, or both, ... and [knowing] that such willful false statements may jeopardize the validity of the application or any resulting registration...." Statements made with such degree of solemnity clearly are – or should be – investigated thoroughly prior to signature and submission to the USPTO. *See Medinol v. Neuro Vasx*, 67 USPQ2d at 1209.

Inasmuch as the USPTO will not issue a registration based on use covering goods upon which the mark has not been used, there is no question that respondent's Statement of Use would not have been accepted nor would the registration have issued but for respondent's representation that it was using the mark on all the goods identified in the Notice of Allowance. *See Trademark Rule 2.88(c)*. *See Id.* at 1208. Thus, the undisputed facts in this case clearly establish that respondent knew or should have known at the time it submitted its statement of use that the mark was

not in use on all of the goods. While the listing of goods was quite lengthy (over 150 items), it was not complicated (i.e., these were all simply items of clothing). Respondent was not using the mark on over 100 (2/3) of the items. Non-use on this great a number of items in a long list of items must be accorded significance when filling in a form requiring a verification stating that respondent was using the mark on "all" of the goods (or allowing respondent to delete those goods or divide out those goods upon which it is not using the mark). In addition, the Board notes that the Statement of Use form is not complicated, and the term "all" has a commonly understood meaning in general as well as in the context of the form.

We conclude that respondent knew or should have known that its Statement of Use was materially incorrect. Respondent's knowledge that its mark was not in use on about 100 of the approximately 150 identified items - or "its reckless disregard for the truth - is all that is required to establish intent to commit fraud in the procurement of a registration." *See Medinol v. Neuro Vasx*, 67 USPQ2d at 1210. While it is clear that not all incorrect statements constitute fraud, the relevant facts in this record allow no other conclusion. We find that respondent's material misrepresentations made in connection with its statement of use were fraudulent. *Id* at 1210.

Accordingly, petitioner's motion for summary judgment is granted; the petition to cancel is granted; and Registration No. 2751107 will be cancelled in due course.¹

¹ Respondent's motion to amend the identification of goods in its registration is denied as moot.